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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,374	11/26/2001	Patrick O'Brien	65678-0045/5676 DCCS	3564

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/995,374	O'BRIEN ET AL.	
	Examiner	Art Unit	
	Clement B. Graham	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Joao 6, 347, 302.

As per claim 1, Joao, discloses a method for benchmarking data relating to an asset, comprising the steps of selecting a group of assets be included in the pool of benchmarking information on a computer.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

identifying on a computer an asset characteristic relating to an asset included in the pool of benchmarking information; and

invoking a benchmark heuristic on a computer to generate a benchmark value relating to the identified asset characteristic;

wherein at least two, organizations contribute to the pool of benchmarking information.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 2, Joao, discloses a wherein the selected group of assets are selected on the basis of a shared asset characteristic. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 3, Joao, discloses further comprising comparing the benchmark value to a characteristic of a target asset. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 4, Joao, discloses wherein the pool of benchmarking information and the benchmark value are stored on a database. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 5, Joao, discloses wherein at least two non-related organizations contribute to the pool of benchmarking information.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 6, Joao, discloses wherein the benchmark value is cost information relating to the asset. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 7, Joao, discloses wherein organizationally identifiable information is not accessible to a end-user.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 8, Joao, discloses wherein an end-user in one organization cannot view organizationally identifiable information belonging to a different organization.

As per claim 9, Joao, discloses a system for benchmarking data relating to an asset, comprising:
a plurality of assets including an asset characteristic and a data value for said asset characteristic.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67) a plurality of organizations with relationships to said plurality of assets;
a benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations; and a benchmark heuristic to generate a benchmark value for said asset characteristic from said benchmarking information pool.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 10, Joao, discloses a system for benchmarking data relating to an asset as in claim 9, wherein said plurality of organizations include at least two unrelated organizations. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 11, Joao, discloses said benchmarking information pool including a plurality of organizationally identifiable data, wherein said plurality of

organizationally identifiable data is hidden from said benchmarking information pool before the application of said benchmarking heuristic.

As per claim 12, Joao, discloses wherein said plurality of organizationally identifiable data is hidden from said plurality of organizations.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 13, Joao, discloses wherein said benchmark value is a monetary amount.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 14, Joao, discloses said plurality of assets including a first asset characteristic, a second asset characteristic and a larger plurality of assets.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67) wherein said plurality of assets are a subset of said larger plurality of assets; wherein said first asset characteristic is included in said benchmarking information pool; and wherein said plurality of assets are selective identified from said larger plurality of assets on the basis of said second asset characteristic.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 15, Joao, discloses wherein said second asset characteristic is not included in said benchmarking information pool.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 16, Joao, discloses further comprising a target asset including said asset characteristic and a target value, wherein said system automatically compares said target value to said benchmark value. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 17, Joao, discloses further comprising a database, wherein said pool of benchmarking information is stored on a database. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 18, Joao, discloses further comprising a plurality of asset values and a plurality of benchmark values, wherein said benchmark heuristic generates said plurality of benchmark values from said plurality of asset values. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

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As per claim 19, Joao, discloses a system for benchmarking data relating to an asset, comprising:

a plurality of assets, including a subset of selected assets, wherein each asset in said plurality of assets includes a plurality of asset characteristics and wherein each said asset characteristic has a data value.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67)

a plurality of organizationally identifiable data, including a subset of said asset characteristics and said data value relating to said asset characteristics;

a plurality of unrelated organizations with relationships to said plurality of assets;

a benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations, and a benchmark heuristic to generate a plurality of benchmark values for said plurality of asset characteristics from said benchmarking information pool. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

Conclusion

3 The prior art of record and not relied upon is considered pertinent to Applicants disclosure.

Brenrent (US 5,774,873 Patent) teaches electronic online motor vehicle auction and information system.

Shintani (US Patent 5,668,591) teaches information terminal apparatus that is remotely programmed by radio waves and that displays input keys of program functions on a display.

Brown (US Patent 5,794,219) teaches method of conducting an online auction with bid pooling.

4. Applicant's arguments filed 1/6/2006 has been fully considered but they are moot in view of new grounds of rejections.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

July 10, 2006


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628